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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATEL, HARESH N

ART UNIT PAPER NUMBER

2154

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,760

Applicant(s)

DEAN, ALAN DEREK

Examiner

Haresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20, are presented for examination.

Response to Arguments

2. Applicant's arguments filed 9/20/04 have been fully considered but they are not persuasive. Therefore, rejection of claims 1-20 is maintained.

Applicant states, (1) "Wu et al. 6,125,369 (Hereinafter Wu) fails to disclose generating an electronic mail address for said person based on said personal name code and said location code and the device for generating a set of standardized electronic mail addresses". The examiner respectfully disagrees in response to applicant's remarks. Wu clearly discloses use of databases (e.g., Microsoft Outlook 97, Schedule+ program, PIM, col., 3, lines 19 – 30, with information device, e.g., col., 3, lines 19 – 30) to generate address (e.g., contact information, such as addresses, phone numbers, etc., col., 3, lines 31 – 41) for the user based on the user name code (e.g., name of a user, col., 18, lines 33 – 39) and said location code (e.g., contact information, such as addresses, phone numbers, city, state, zip code, etc., col., 3, lines 31 – 41) and the device (e.g., information device, e.g., col., 3, lines 19 – 30) for generating a set of standardized (i.e. identical / consistent / uniform, col., 3, lines 31 – 41) addresses (e.g., contact information, such as addresses, phone numbers, etc., col., 3, lines 31 – 41, synchronization of information using communication mechanism, col., 3, line 59 – col., 4, line 8). Wu also clearly discloses that all type of communication mechanism are used for synchronizing addresses, e.g., col., 3, line 59 – col., 4, line 8. As mentioned in the office action, date 6/16/2004, electronic mail and electronic mail addresses are inherent use of Microsoft Outlook 97. To support inherency of the office

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action, date 6/16/2004, Gilmour et al., 6,154,783, teaches electronic mail and electronic mail addresses used by Microsoft Outlook 97, etc., e-mail programs, col. 6, lines 41 - 62. Also, page 9, lines 1-6, clearly states, "the preferred embodiment provides a system for correlating the details of individuals with a standardized method of communicating with those individuals via electronic means". Since, applicant's claims contain broadly claimed subject matter, i.e., use of any preferred electronic means, etc., it clearly reads upon the examiner's interpretation of these actions. Therefore, rejection is maintained.

Applicant states, (2) "Wu to disclose logic configured to generate an electronic mail address for said person based on said personal name code and said location code and generating an electronic mail address for said person based on said personal name code and said location code". The examiner respectfully disagrees in response to applicant's remarks. Wu clearly discloses logic configured to generate an address (e.g., use of information device, to generate addresses, e.g., col., 3, lines 19 – 41) using databases (e.g., Microsoft Outlook 97, Schedule+ program, PIM, col., 3, lines 19 – 30, with information device, e.g., col., 3, lines 19 – 30) to generate address (e.g., contact information, such as addresses, phone numbers, etc., col., 3, lines 31 – 41) for the user based on the user name code (e.g., name of a user, col., 18, lines 33 – 39) and said location code (e.g., contact information, such as addresses, phone numbers, city, state, zip code, etc., col., 3, lines 31 – 41) and the device (e.g., information device, e.g., col., 3, lines 19 – 30) for generating a set of standardized (i.e. identical / consistent / uniform, col., 3, lines 31 – 41) addresses (e.g., contact information, such as addresses, phone numbers, etc., col., 3, lines 31 – 41, synchronization of information using communication mechanism, col., 3, line 59 – col., 4, line 8). Wu also clearly discloses that all type of communication mechanism are used for

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synchronizing addresses, e.g., col., 3, line 59 – col., 4, line 8. As mentioned in the office action, date 6/16/2004, electronic mail and electronic mail addresses are inherent use of Microsoft Outlook 97. To support inherency of the office action, date 6/16/2004, Gilmour et al., 6,154,783, teaches electronic mail and electronic mail addresses used by Microsoft Outlook 97, etc., e-mail programs, col. 6, lines 41 - 62. Also, page 9, lines 1-6, clearly states, “the preferred embodiment provides a system for correlating the details of individuals with a standardized method of communicating with those individuals via electronic means”. Since, applicant's claims contain broadly claimed subject matter, i.e., use of any preferred electronic means, etc., it clearly reads upon the examiner's interpretation of these actions. Therefore, rejection is maintained.

Applicant argues, (3) “Wu does not disclose all of the features of claims 1-20”. The examiner disagrees in response to applicant's arguments. The rejected claims 1-6 of office action, dated 6/16/2004, contained method steps. The currently amended claims 1-6 represent a program storage device. The currently amended claim 7, contain configured logic. Also, the limitations, “the person's electronic mail address, country specific address locator code”, etc., has been newly added, hence the scope of the presently amended claims, is narrower compared to the originally presented claims. The amended claims 1-12, with the newly presented claims 13-20, are addressed by the new ground(s) of rejection (please refer to the below rejections of this office action), necessitated by the applicant's amendment. Therefore the rejection is maintained as disclosed above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 5, 6, 9-13, 15, 16, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 3, 5, 6, 9-13, 15, recite the limitation "the person's". There is insufficient antecedent basis for this limitation in the claim. Since, independent claims 1 and 7, contain multiple unrelated person, it is not clear which person is referred by this limitation.

5. Claims 16, 20, recite the limitation "generating the electronic mail address for the person by attaching an indicator to the electronic mail address". There is insufficient antecedent basis for this limitation in the claim. Since, independent claims 1 and 7, also contain "generating the electronic mail address" limitation, it is not clear which "electronic mail address" belongs to which "generating the electronic mail address" limitation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4, 7, 8, 10, are rejected under 35 U.S.C. 102(b) as being anticipated by Wu et al. 6,125,369 (Hereinafter Wu).

8. As per claims 1 and 7, Wu teaches the following:

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a program storage device readable by a machine and encoding a program of instructions / a system (e.g., use of information device, e.g., col., 3, lines 19 – 30) for generating a set of standardized electronic mail addresses (e.g., configuration of plurality of properties and addresses of Microsoft 97, electronic mail and electronic mail addresses are inherent use of Microsoft Outlook 97, creation/setting/update of uniform properties of address for plurality of users, col., 3, lines 31 – 41),

logic configured to providing a personal name code indicative of the name of a person (e.g., a name of user, col., 18, lines 33 – 39),

logic configured to providing a location code indicative of a known location of the person (e.g., street address, city, state , zip code, etc., col., 18, lines 33 – 39),

logic configured to generating an electronic mail address (e.g., contact information, such as addresses, phone numbers, etc., col., 3, lines 31 – 41, synchronization of information using communication mechanism, col., 3, line 59 – col., 4, line 8, electronic mail and electronic mail addresses are inherent use of Microsoft Outlook 97, col., 3, lines 31 – 41) for said person based on said personal name code and said location code (e.g., creation of database entry containing user specific parameters for a user, col., 17, line 20 – col., 18, line 63, col., 20, lines 8 – 57), and

logic configured to providing a database of said electronic mail addresses for a plurality of persons at one or more locations (e.g., user specific address information available from a primary computer or a portable computer, abstract, electronic mail and electronic mail addresses are inherent use of Microsoft Outlook 97, col., 3, lines 31 – 41).

9. As per claims 2, 4, 8, 10, Wu teaches the following:

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the location code is a postal or area code (e.g., street address, col., 18, lines 33 – 39),
one or more structured addresses are created for each individual in a country, geographic region or state (e.g., city, col., 18, lines 33 – 39).

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-5, 7-11, 13, 15, 17, 19, are rejected under 35 U.S.C. 102(e) as being anticipated by Jambhekar et al. 6,430,405 (Hereinafter Jambhekar).

12. As per claims 1 and 7, Jambhekar teaches a program storage device readable by a machine and encoding a program of instructions / a system for generating a set of standardized electronic mail addresses (e.g., figure 5-17, col., 2, lines 48 – 55, col., 5., lines 38 – 58), said instructions operable to:

logic configured to provide a personal name code indicative of the name of a person (e.g., figure 11-4),

logic configured to provide a location code indicative of a known location of the person (e.g., figure 11-6, inherent location information based on the area code of the telephone number, also, col., 2, lines 60 – 64, col., 6, lines 53 - 63),

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logic configured to generate an electronic mail address for said person based on said personal name code and said location code (e.g., figures 10-7, 10-8, 5-16, 5-17, col., 2, lines 48 – 55, col., 5, lines 38 – 58), and

logic configured to provide a database of said electronic mail addresses for a plurality of persons at one or more locations (e.g., figures 5-3, 5-12, 5-17, col., 5, lines 38 – 58, col., 6, lines 11 – 28).

13. As per claims 2, 8, Jambhekar teaches the following:

the location code is a telephone area code of a telephone number (e.g., figure 5-17, col., 6, lines 53 - 65).

14. As per claims 3, 9, Jambhekar teaches the following:

the personal name code includes at least a the person's family name (e.g., figure 5-13).

15. As per claims 4, 10, Jambhekar teaches the following:

one structured address is created for each individual in a geographic region (e.g., col., 2, lines 56 – 67, col., 6, lines 53 - 65).

16. As per claims 5, 11, Jambhekar teaches the following:

one or more subsidiary addresses, including existing electronic addresses, are attached to the person's electronic mail address in the database (e.g., col., 2, lines 40 – 55).

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17. As per claims 13, 17, Jambhekar teaches the following:

collect the name and the known location of the person from an information source (e.g., col., 6, lines 53 – 67).

18. As per claims 15, 19, Jambhekar teaches the following:

locate the electronic mail address of the person in the database (e.g., figure 5-17, col., 2, lines 40 – 55).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 6, 12, 14, 16, 18, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jambhekar in view of Official Notice.

21. As per claims 6, 12, 16, 20, Jambhekar teaches the claimed limitations as rejected under claims 1 and 7. However, Jambhekar does not specifically mention about attaching a unique identifier to the person's electronic mail address and after determining that the electronic mail address is non-unique attaching an indicator. "Official Notice" is taken that both the concept and advantages of providing attaching a unique identifier to the person's electronic mail address and after determining that the electronic mail address is non-unique attaching an indicator is well known and expected in the art.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to include attaching a unique identifier to the person's electronic mail address and after determining that the electronic mail address is non-unique attaching an indicator with the teachings of Jambhekar in order to facilitate each electronic mail address to be identified among other electronic mail addresses. By having a unique identifier for each electronic mail address, it would help identify each electronic mail address differently from the other electronic mail addresses. Attaching an indicator to the electronic mail address would help indicate that the same electronic mail address is used by two different persons.

22. As per claims 14, 18, Jambhekar teaches the claimed limitations as rejected under claims 1 and 7. However, Jambhekar does not specifically mention about providing the database of electronic mail addresses on-line. "Official Notice" is taken that both the concept and advantages of providing the database of electronic mail addresses on-line is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include providing the database of electronic mail addresses on-line with the teachings of Jambhekar in order to facilitate accessing to the database over the on-line devices/resources. Having the database containing electronic mail addresses information available online, would help access the information using the well-known on-line devices/resources.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

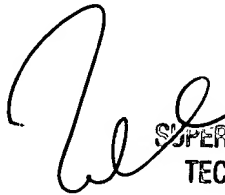
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

January 18, 2005

 JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100